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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/992,861
Filing Date: November 14, 2001
Appellant(s): KELDERS ET AL.

Glenn e. Murphy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 21, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 3-8, 10-13, and 15-20 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8), and that claim 14 does not stand or fall with claims 1, 3-8, 10-13, and 15-20.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

2,584,065	TAYLOR	1-1952
3,895,059	LINK	7-1975

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-8, 10, 12-14 and 16-20 are rejected under 35 U.S.C. 102b) as being anticipated by Taylor.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Link.

These rejections are set forth in a prior Office Action, mailed on 10-20-03.

(11) Response to Argument

Appellants' first argument is that Taylor's opening 32 is structurally different from the claimed depression in that it does not form part of the cover upon which the user places a finger (pg 5, L 19-21; pg 6, L 21-22).

In response, Appellant is referring to claims 1, 12, and 16, where it is recited that "the top of the cover piece has at least one depression for placement of a finger". Note that this limitation does not recite what Appellants are arguing. Claims 1, 12, and 16 do not require that the depression form part of the cover piece "upon" which the user places a finger. In Taylor, the top of cover piece 2 has at least one depression 32 for placement of a finger (c 3, L 44-50) -- which is all that is claimed. In Taylor, the finger contacts roller 9; however, claims 1, 12, and 16 does not restrict the depression from being an open area, such as area 32 of Taylor, without the finger being upon the cover piece within the depression.

Appellants refer to the specification at pages 10, 11, 16, and 20 where it is recited that the finger "may rest comfortably on the depression" and that the depression may have ridges on its surface (pg 5, L 24-27). Also, see page 6, lines 12-14.

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In response, these limitations are not claimed. Claims 1, 12, and 16 do not recite that the cover piece has at least one depression for placement of a finger on the cover piece with in the depression. Also, claims 1, 12, and 16 do not recite that the depression has ridges.

Appellants indicate that the claimed depression is part of the cover which the opening 32 Taylor is not (pg 6, L 1-2).

In response, opening 32 of Taylor is part of cover piece 2 in that it is an opening within cover piece 2.

Appellants indicate that the depression, unlike Taylor's opening 32, has a surface upon which "the index finger can rest comfortably" and refer to the specification at page 10, line 19. Also, Appellant indicates that opening 32 of Taylor does not (pg 6, L 3-10).

In response, claims 1, 12, and 16 does not recite that the depression "has a surface upon which the index finger can rest comfortably." Claims 1, 12, and 16 only recites that "the top of the cover piece has at least one depression for placement of a finger".

Appellants indicate on page 6, lines 11-21, that the claimed structure and that of Taylor function differently, and goes on to explain how that of Taylor function.

In response, claims 1 and 12 are apparatus claims where the claims are not recited to include any functional limitation that have any structural impact on the apparatus claimed. Claim 16 is a method claim where the is provided an apparatus having many limitations including a top cover piece having at least one depression for placement of a finger. The three method steps include providing the apparatus (step a), mounting a roll in the housing of the apparatus (step b), and applying the material using the apparatus (step c). Taylor teaches each of steps a, b, and c as claimed as well as the structural limitations in step a, items I-VI, including that cover piece 2 has at least one depression 32 for placement of a finger. Claim 16 does not preclude the function of the apparatus of Taylor, i.e., providing depression 32 to push forwardly on roller 9 (c 4, L 3-7).

Appellants' comment on page 6, last 5 lines, to page 7, line 1, is noted.

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In response, Taylor does not fail to disclose the claimed subject matter in claims 1, 12, and 16 in that if Appellants desire claim coverage for the placement of a finger to be upon the cover piece when placed over the depression, then such limitation should be claimed. It is granted that Taylor's depression 32 allows for the finger to contact roller 9 when placed over the depression (c 4, L 3-7); but, claims 1, 12, and 16 are not provided with any limitation to overcome the reference, i.e., that the finger is upon the cover piece when placed in the depression.

Appellants' comments on page 7, lines 1-11, are noted. Appellants indicate that it is clear in light of the specification that a depression has a surface.

In response, this limitation is not claimed.

Appellants indicate on page 7, lines 12-27 that one would not rest one's finger on a mechanism used only periodically (i.e., for roller the feed roller 9) and where doing so would stop the tape supply and render the device inoperative.

In response, claims 1 and 12 are apparatus claims where the claims are not recited to include any functional limitation that have any structural impact on the apparatus claimed. Claim 16 is a method claim where the is provided an apparatus having many limitations including a top cover piece having at least one depression for placement of a finger. The three method steps include providing the apparatus (step a), mounting a roll in the housing of the apparatus (step b), and applying the material using the apparatus (step c). Taylor teaches each of steps a, b, and c as claimed as well as the structural limitations in step a, items I-VI, including that cover piece 2 has at least one depression 32 for placement of a finger. Claim 16 does not preclude the function of the apparatus of Taylor, i.e., providing depression 32 to push forwardly on roller 9 (c 4, L 3-7). Claim 16 do not provide any method limitations which would render the claimed method patentable over the method of use of the apparatus of Taylor. Again, the three method steps of claim 16 include providing the apparatus (step a), mounting a roll in the housing of the apparatus (step b), and

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applying the material using the apparatus (step c). Taylor teaches each of steps a, b, and c as claimed.

In response to Appellants' comment on page 7, line 27, to page 8, line 16, it is noted that the prior art rejection does not indicate that Taylor's depression 32 be modified to include part of the cover piece under the finger for such would destroy the reference. Actually, the Examiner is indicating that the pending claims do not require there to be cover piece in the depression upon which the finger rests such that Taylor meets the limitation of claims 1, 12, and 16 with respect to the depression: i.e., that the cover piece has at least one depression for placement of a finger.

Appellants indicate on page 8, last line, to page 9, line 2, that Taylor's Figure 3 does not show depressions to help grip the device with the thumb and forefinger as claimed.

In response, Appellants are referring to claim 14, i.e., that "the cover piece has one or more depressions on the sidewalls for placement of a thumb or fingers". Note that this limitation does not recite what Appellants are arguing. Claim 14 do not require depressions to help grip the device with the thumb and forefinger.

Appellants indicate on page 9, lines 3-11, that Figure 1 of Taylor shows depressions on the sidewalls which, Appellants indicate, are too narrow to fit a finger.

In response, note in Figure 1, as well as Figure 6, that cover piece 2 of Taylor is tear-dropped shaped with a bulbous structure at the larger end. This structure provides for depressions on the sidewalls in that the edges of the top of cover piece 2 are in a different plane than the bottom edges -- because of the bulbous structure. Thus, Taylor meets the limitation of cover piece 2 having one or more depression on the sidewalls as claimed in claim 14, i.e., the depressed areas on the sidewalls being that area along the bottom of cover piece 2 next to the top of item 1 -- under the bulge of the bulb shape. With respect to the further limitation of claim 14 that a thumb or finger can be placed on the depressions, Taylor does not specifically indicate how

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to hold the apparatus. However, it is clear from the drawings of the apparatus of Taylor, and the related description, that the area of the depressions of Taylor are large enough for placement of a thumb or finger, contrary to Appellants' comments.

Appellant indicates that a user attempting the grasp the device between the thumb and middle or forefinger on cover piece 2 of Taylor would gain no hold nor be able to support or use the apparatus (pg 9, L 11, to pg 20, L 2).

In response, claim 14 does not require the apparatus to be grasp between the thumb and middle or forefinger. Claim 14 only requires placement of a thumb or fingers on the depressions which is not the same as a grasping the device between the thumb and middle or forefinger. In any event, the act of grasping the device is actually an argument geared to use of the claimed apparatus where claim 14 is a product claim and not a method claim. Also, a manner of grasping the apparatus isn't provided in claim 14.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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March 11, 2005



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